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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Paul Greer

Application No.: 08/882,197

Filed: June 25, 1997

For: **USER DEMOGRAPHIC PROFILE
DRIVEN ADVERTISING TARGETING**

Examiner: Susanna M. Meinecke Diaz

Art Group: 3623

REPLY BRIEF

BOX AF
Assistant Commissioner for Patents
Washington, DC 20231-9998

Dear Sir:

Appellant submits the following Reply Brief pursuant to 37 C.F.R. § 1.193(b) for consideration by the Board of Patent Appeals and Interferences. The Reply Brief is directed to the new points of argument raised in the Examiner's Answer.

I. Response to New Points of Argument Raised in Examiner's Answer as to Independent Claims 3 and 17 in view of O'Toole further in view of Davis and even further in view of Official Notice.

In the Examiner's Answer, the Examiner asserts on page 10 that O'Toole's smart digital offer object functions as the claimed "first agent," and that "profile information" functions as the claimed user rule page. In support thereof, the Examiner mainly relies on column 7, line 24 through column 8, line 4 of O'Toole.

However, Appellant respectfully submits that contrary to the Examiner's assertion, O'Toole does not particularly teach or suggest the limitations of independent claims 3 and 17 related to a user rule page containing information *automatically obtained from the target computer by a first agent* having a trigger program to filter information and to determine whether the information is relevant to the user rule page.

Looking particularly at selected portions of O'Toole, column 7, lines 24 through column 8, line 21, O'Toole teaches:

The client computer fetches a document of web-based information from the offer-providing server that contains a smart digital offer object (step 118)...The client computer activates the smart digital offer object (step 120), and the smart digital offer object attempts to observe the parameters of the execution environment at the client machine, including the presence of coupons, and possibly other information such as a purchasing history recorded on the client computer....If the smart digital offer object attempts to observe the purchasing history or certain other user-specific information, the client computer asks the user whether the user wishes to reveal the information (step 122). The user indicates whether release of the information is authorized (step 124), and the smart digital offer object then examines the coupon (including the coupon's authenticator), digital receipts (including authenticators) and other user-specific information authorized to be revealed by the user, and presents to the user an offer of a product or service (step 126)...When the user accepts the offer (step 128) the client computer sends a message to the offer-providing server indicating that the user has accepted the offer, or sends the message to an intermediary server that is trusted by the client computer to maintain the confidentiality of user-specific information and is trusted by the offer-providing server to verify the terms on which the offer was accepted (step 130)...The offer-providing server then fulfills the offer by causing the offered product or service to be provided to the user (step 134). (O'Toole, column 7, line 24 through column 8, line 21) (Emphasis Added).

As particularly detailed above, in O'Toole, O'Toole teaches an interactive smart digital offer object to allow a user to be interactively asked whether the user wishes to reveal certain user information and that further asks the user if the user wishes to accept an offer of a product or a service, which the user can then interactively accept or decline. This is completely different from Appellant's claimed invention of independent claims 3 and 17 related to a user rule page containing information automatically obtained from the target computer by a first agent having a triggering program to filter information and to determine whether the information is relevant to a user rule page. There is simply no teaching or suggestion of the automatic gathering of information from a target computer - but rather a query session is disclosed to determine whether a user accepts an offer.

Further, Appellant set forth in its previous Appeal Brief, that nowhere does O'Toole teach, suggest, or render obvious a *second agent that updates information* (after a first agent) in a user rule page (which includes at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user including information on web-sites visited and time spent by the user on the web-sites) and *based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the computer*.

The Examiner responsive thereto has stated that O'Toole teaches that each time a server targets an offer to a user...the server sends along a smart digital offer object...a client "avatar" controls the release of the user's personal information to the server...this updated profile information is used by the server to target future offers to the user through smart digital offer objects...therefore, O'Toole teaches the use of various objects (including "avatars") to select and deliver offers of interest to a user and updates a user's profile accordingly. [Examiner's Answer, pages 12-13]. Further, the Examiner asserts that the smart digital offer objects relays the updated profile information back to the offer-providing servers in order to assess the targeting of future offers [Examiner's Answer, page 13].

However, O'Toole states that:

The server computer may use the subset of the client personal profile to customize other web-based services offered to the user, including digital coupons, search services, and advertisements...Client-specific sales offers and coupons can be implemented in accordance with the smart digital offer techniques described above in connection with FIGS. 3 and 4A-4B. (O'Toole, Column 10, lines 17-24, Emphasis Added).

Thus, Appellant respectfully submits that to the extent O'Toole teaches or suggests a second agent that updates information in the user rule page...and based upon the updated user rule page finds new appropriate content including a second advertisement; that this is based upon the same sort of *interactive querying* (Figures 3, 4A, 4B) that has been previously discussed and does not relate to a user page that is automatically obtained from the target computer.

Further, on pages 13-14 of the Examiner's Answer, the Examiner disagrees with Appellant's assertion that there is no motivation to combine the teachings of Davis with O'Toole and further with Official Notice, in order to teach the hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer, the dynamic information including information on web-sites visited and time spent by a user on the web-sites.

The Examiner asserts that the Appellant's analysis of Davis is in a vacuum, and not in light of the rejection over the combination of O'Toole, Davis, and Official Notice as a whole.

Appellant respectfully disagrees. Appellant respectfully submits that the combination of O'Toole, Davis, and Official Notice is in fact improper hindsight reconstruction.

As aptly stated by the Federal Circuit in *In re Kotzab*, 55 USPQ2d (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus every element of a claimed invention may often be found in the prior art. *However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. (Emphasis added).

Further, it is has long been held that impermissible hindsight reconstruction must be avoided.

The Federal Circuit has ruled that it is impermissible to use the claims as an instruction manual or "template" to piece together teachings of the prior art to render a claimed invention obvious. *See Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554, (Fed. Cir. 1996). "Virtually all [inventions] are combinations of old elements." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457. An examiner may often find every element of a claimed invention in the prior art. However, if merely identifying each claimed element in the prior art was sufficient to negate patentability, very few patents would ever issue. *Id.* Rejecting patent claims solely by finding "prior art corollaries" for the claimed elements permits an examiner to use the claimed invention itself as a blueprint for piecing elements in the prior art together. *Id.* To defeat the patentability of a patent application in this manner is inappropriate. *Id.*

Appellant respectfully submits that the limitations of independent claims 3 and 17 are not taught, suggested, or rendered obvious by O'Toole in combination with Davis, and further in combination with, what the Examiner alleges, would have been obvious to one of ordinary skill in the art (i.e. Official Notice). As has been discussed, Appellant respectfully submits that the Examiner is *utilizing impermissible hindsight* to piece together disparate sections of the O'Toole and Davis references, along with what would have allegedly been obvious to one of ordinary skill in the art to, *in hindsight*, approximate Appellants claimed invention.

As set forth in the Abstract of O'Toole, O'Toole generally teaches:

"The present invention relates to techniques for controlling transfers of information in computer networks. One technique involves transmitting from a server computer to a client computer, a document containing a channel object corresponding to a communication service, and storing an access ticket that indicates that a user of the client computer permits the information source computer to communicate with the user over a specified channel. Another technique involves transmitting smart digital offers based on information such as coupons and purchasing histories stored at the computer receiving the offer..."

The Examiner previously held that O'Toole does not explicitly disclose how the confirmation of compatibility between the client and servers communication hardware and software is established - but that Davis teaches the monitoring of client activity in order to create a client profile that is used to target content such as an ad to a user. The Examiner has further previously asserted that Davis teaches the ability to use an agent to obtain data regarding hardware characteristics of the target computer. Further, the Examiner has asserted that Official Notice is taken that it is old and well-known in the art of computers to access a software profile. Further, the Examiner has asserted that although O'Toole does not explicitly teach the profiling of web-sites visited and time spent at each web-site by a user, that Davis makes up for this deficiency.

Thus, the Examiner has previously used Davis to teach the ability of an agent to obtain data regarding hardware characteristics of a target computer and to show that it has been known to track dynamic information including information on web-sites visited and time spent by users on the websites. Although, even Davis, does not particularly teach or suggest a user rule page including a software profile indicating software used by the target computer; such that the Examiner has taken Official Notice that it is old and well-known in the art of computers to access a software profile.

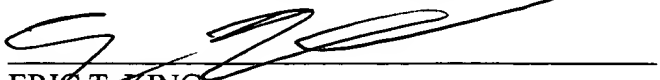
As before, Appellant reiterates, and Appellant respectfully submits that this is classic hindsight reconstruction. Appellant respectfully submits that O'Toole as set forth by the Examiner provides techniques to transmit smart digital offers based on information such as coupons and purchasing histories stored at the computer receiving the offer and, to begin with, does not teach or suggest a user rule page containing information automatically obtained from the target computer by a first agent. Beyond that, it is Appellant's belief that the Examiner has engaged in hindsight reconstruction to pick and choose disparate parts of the O'Toole reference in combination with disparate references of the Davis reference, along with Official Notice of skill in the art, to piece together the teachings of the prior art in an attempt to render obvious the claimed invention, when there is no motivation to do so except to re-create Appellant's claimed invention.

Appellant respectfully submits that O'Toole in combination with Davis, and further in combination with Official Notice simply does not teach or suggest Appellant 's novel and non-obvious invention related to: a user rule page containing information *automatically obtained from a target computer by a first agent* having a triggering program to filter information and determine whether the information is relevant to the user rule page...a rule book to provide a rule based on the user rule page...the user rule page including at least one of *a hardware profile, a software profile, and a user profile including dynamic information related to a user using the target computer including information on web-sites visited and time spent by the user on the web-site* and wherein *a second agent updates* information in the user rule page based on information received from the target computer and *based upon the updated user rule page finds new appropriate content including a second advertisement* that is transmitted to the target computer.

In view of the foregoing, Appellant respectfully submits that independent claims 3 and 17 are not rendered obvious by the hindsight combination of O'Toole, Davis, and what would have been allegedly known to one of ordinary skill in the art (i.e. Official Notice), and that these claims should be allowed. Appellant respectfully requests that the Board reverse the Examiner's decision as to independent claims 3 and 17. With respect to the dependent claims, Appellant respectfully submits that these claims are allowable for being dependent upon allowable independent claims.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP


ERIC T. KING

Reg. No. 44,188

Dated: September 14, 2004

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application No.	08/882,197
		Filing Date	June 25, 1997
		First Named Inventor	Paul Greer
		Art Unit	3623
		Examiner Name	Susanna M. Diaz
Total Number of Pages in This Submission	10	Attorney Docket Number	42390P4072

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 10px;">Reply Brief</div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Eric T. King, Reg. No. 44,188 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	September 14, 2004

CERTIFICATE OF MAILING/TRANSMISSION			
I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.			
Typed or printed name	Nicole Erquiaga		
Signature		Date	September 14, 2004



FEE TRANSMITTAL for FY 2004

Effective 01/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$)

Complete if Known

Application Number	08/882,197
Filing Date	June 25, 1997
First Named Inventor	Paul Greer
Examiner Name	Susanna M. Diaz
Art Unit	3623
Attorney Docket No.	42390P4072

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account

Deposit
Account
Number

02-2666

Deposit
Account
Name

Blakely, Sokoloff, Taylor & Zafman LLP

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) or underpayment of fees as required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

2. EXTRA CLAIM FEES

Total Claims - 51** = X =
Independent Claims - 3 = X =
Multiple Dependent

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple Dependent claim, if not paid	
1204	86	2204	43	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$)

**or number previously paid, if greater, For Reissues, see below

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920 *	1804	920 *	Requesting publication of SIR prior to Examiner action	
1805	1,840 *	1805	1,840 *	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1404	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	1809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					
SUBTOTAL (3)					(\$)

* Reduced by Basic Filing Fee Paid

SUBMITTED BY

Complete (if applicable)

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Signature		Date	09/14/04		